



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,263	10/11/2000	Milan Mrksich	7814/42	8463

757 7590 12/13/2001

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, IL 60610

EXAMINER

NAFF, DAVID M

ART UNIT	PAPER NUMBER
----------	--------------

1651

DATE MAILED: 12/13/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/689263

Applicant(s)

Mitsich et al

Examiner

Naff

Group Art Unit

1657

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-58 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-58 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Claims in the application are 1-58.

Restriction to one of the following inventions is required under  
35 U.S.C. 121:

I. Claims 1-8, 37 and 38, drawn to an alkanethiol and method for  
preparation thereof, classified in class 568, subclass 18.

II. Claims 9-18, 39 and 40, drawn to a disulfide and method for  
preparation thereof, classified in class 568, subclass 21.

III. Claims 19-36, 41-44 and 49-58, drawn to a substrate having a  
surface layer containing alkanethiolate moieties, a cell chip  
containing the substrate and cells on the substrate, a method  
of making a substrate by contacting a surface with an  
alkanethiol and a method of making a cell chip by contacting  
cells with the substrate, classified in class 435, subclass  
395.

IV. Claims 45-48, drawn to a method of making a substrate by  
contacting a surface with a disulfide, classified in class 435,  
subclass 181.

The inventions are distinct, each from the other because:

The alkanethiol of I is different in structure from the disulfide of  
II, and preparing the alkanethiol requires different steps than used to  
prepare the disulfide. Additionally, the alkanethiol can have a  
different use from the disulfide due to the alkanethiol having an HS-  
group and the disulfide having an -S-S- bond. The former can be oxidized  
and the latter can be reduced. The alkanethiol and disulfide can have  
uses other than being part of a substrate as required by III and IV such  
as to form a liposome, or to function as a reducing or oxidizing agent or

as a crosslinking agent. Additionally, the substrate of claims 19-29 of III can be formed without the alkanethiol of I since in preparing the substrate the thiol of the alkanethiol can be replaced with another sulfur-containing substituent. III and IV are distinct because of  
5 differences in the alkanethiol and disulfide specified above.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

10 Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37  
15 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications  
20 from the examiner should be directed to David M. Naff whose telephone number is (703) 308-0520. The examiner can normally be reached on Monday-Thursday and every other Friday from about 8:30 AM to about 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, a  
25 message can be left on voice mail.

Application Number: 09/689,263  
Art Unit: 1651

Page 4

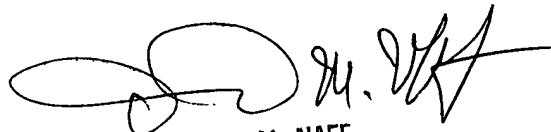
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn, can be reached at telephone number (703) 308-4743.

The fax phone number is (703) 305-3014 or 308-4242.

5 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

10

DMN  
12/12/01

  
DAVID M. NAFF  
PRIMARY EXAMINER  
ART UNIT 12657